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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,942	01/03/2002	Alain M. Sagnard	61301A	7761

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THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/037,942

Applicant(s)

SAGNARD ET AL.

Examiner

Jane Rhee

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-12 and 15-22.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: see attachment

ADVISORY ACTION

Response to Arguments

1. Applicant's arguments filed 11/19/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Grinsphun teaches multiple cavities and not a single cavity that the panel can apply sufficient pressure against the cavity walls to as to frictionally retain the panel in the cavity, Grinsphun does disclose a single cavity wherein the panel fits fully within the cavity and that the panel applies sufficient pressure against the cavity walls to as to frictionally retain the panel in the cavity. The single cavity taught by Grinsphun is the frame of the building construction as depicted in figure 1A number 1. Prior to the support members being attached to the frame, the frame defined a single cavity. Although the support members and the foam were inserted into the frame, occupying the frame, the frame itself is still a cavity.

Applicant claim "a building panel comprising at least two panel domains...fits fully within a cavity defined by cavity walls and, when in the cavity, the building panel has a compressive recovery that supplies sufficient pressure against the cavity walls to frictionally retain the building panel within the cavity." First of all, the phrase "when in a cavity" is unclear whether the applicant is claiming a cavity with the building panel or if applicant is claiming that the panel domains are capable of being in a cavity. Secondly, applicant claim "a building panel *comprising* at least two panel domains," which leads to the possibility of other structural members to be included in the building panel along with the two

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panel domains since "comprising" is an open language limitation. Also, applicant did not claim that structural support members disclosed by Grinsphun couldn't be a part of the building panel. Therefore, the building panel can comprise two panel domains and structural support members, which fits fully within the cavity. Grinsphun discloses a building panel comprising at least two panel domains (figure 6 number 60 and 61) that fits fully within a single cavity (figure 1A number 1, col. 2 lines 64-65).

Applicant argues that building panel must supply sufficient pressure against the cavity walls so as to frictionally retain the panel within the cavity and that the panel of Grinsphun not only spans multiple cavities but holds itself in place by clamping onto a cavity wall. Grinsphun teaches that the foam sheet is positioned adjacent to the frame and pushed against the frame so that the support members go into the grooves (col. 2 lines 58-60) and further teaches that when the foam is brought into contact with the support member, the areas of the foam sheet adjacent to the groove may be compressed as needed to more easily admit the support member into the groove and then the compressible and resilient portion of the foam will then expand after the support member is inserted so as to at least partially fill small irregularities in the side of the support member and ensure a tight fit of the support member in the groove (col. 3 lines 56-63). Therefore, the combination of the support members and the foam creates sufficient pressure against the cavity walls so as to frictionally retain the panel within the cavity (col. 2 lines 58-60, col. 3 lines 52-63).

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Applicant argues that the specification defines a cavity as "a volume between two studs or two joists", and that Grinshpun identifies support members between the studs therefore, Grinshpun does not disclose a cavity as defined in the present application. As discussed above, the single cavity taught by Grinshpun is the frame of the building construction as depicted in figure 1A number 1. Prior to the support members being attached to the frame, the frame defined a single cavity. Although the support members and the foam were inserted into the frame, occupying the frame, the frame itself is still a cavity.

In response to applicant's argument that the panel of Grinshpun extends over a support member and cannot fit within a single cavity because it extends beyond the volume defined by two cavity walls, as explained earlier, the single cavity taught by Grinshpun is the frame of the building construction as depicted in figure 1A number 1. Prior to the support members being attached to the frame, the frame defined a single cavity. Although the support members and the foam were inserted into the frame, occupying the frame, the frame itself is still a cavity.

Applicant further argues that a cavity cannot include a vertical support member in the context of Grinshpun's framework since the vertical support member will divide the volume into distinct volumes, even though the vertical support will divide the volume into distinct volumes the framework still consist of "a volume" which by definition is a cavity according to Merriam Webster Unabridged Dictionary which defines a cavity as "a three dimensional discontinuity in the substance of a mass or body; a space within a mass; a spaced hollowed out" (see applicant's arguments on page 4). Applicant desires

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to fill the cavity with a building panel therefore, the frame disclosed by Grinshpun is a spaced hollowed out prior to the building panel being inserted within whereby the building panel disclosed by Grinshpun have a combination of foam and support members.

In response to applicant's argument that Grinshpun does not disclose, teach or suggest a panel that fits "fully within" a cavity defined by cavity walls, as described above, the single cavity taught by Grinsphun is the frame of the building construction as depicted in figure 1A number 1. Prior to the support members being attached to the frame, the frame defined a single cavity. Although the support members and the foam were inserted into the frame, occupying the frame, the frame itself is still a cavity. Therefore, the building panel fits fully within a cavity defined by cavity walls (col. 2 liens 64-65) as taught by Grinsphun. Applicant focuses on the fact that the support members create the cavity walls and that the panel extends out of the support members therefore cannot be fitted fully within a cavity and determined that the frame itself cannot be a cavity due to definition defined in Webster's dictionary, however fail to realize that applicant's present invention desires to have their cavity filled with foam which therefore, no longer becomes a cavity. With the same teaching of filling a cavity, Grinsphun teaches a single cavity that's being filled with foam but also includes support members.

In response to applicant's argument that Grinshpun et al. fail to disclose that the at least one panel domain is a conformable panel domain that allows the panel to reversibly bend from a planar to a non planer configuration, applicant

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claimed that "at least one panel domain is a conformable panel domain that *allows* the panel to reversibly bend from a planar to a non planer configuration" meaning that the panel domain only has to be capable to reversibly bend from a planar to a non planar configuration and not be bent in a non planer configuration. Grinshpun et al. discloses two panel domains, number 60 the rigid foam and number 61 the compressible and resilient foam (col. 4 lines 65-66). The compressible and resilient foam by definition allows the panel to reversibly bend or bend in any direction from a planar to a non planar or any other configuration. Therefore, Grinshpun et al. discloses at least one panel domain is a conformable panel domain that allows the panel to reversibly bend from a planar to a non planer configuration (col. 4 lines 65-66).

Applicant argues that one of the foams is "rigid" foam, which is not expected to bend without breaking therefore, cannot reversibly bend from a planar to a non planar configuration. Grinshpun et al. discloses in col.4 lines 6-10 that the entire foam sheet can be of compressible and resilient material and that it is only necessary that the portions of the sheet adjacent to the board be compressible and resilient and other portions of the foam can be *more* rigid. Applicant claim two panel domains with two different compressive strengths therefore, one of the panel domains is going to be *more* rigid than the other panel domain which is the only way to obtain two different compressive strengths. Therefore, Grinshpun et al. teaches two different panels with two different compressive strengths wherein one panel is more rigid than the other panel.

The term "rigid" is a relative term which renders the claim indefinite. The term "rigid" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since the term "rigid" is a relative term, meaning that all things are "rigid" to a degree applicant cannot assert that Grinshpun et al.'s compressible and resilient material is not capable of bending from a planar to a non planer configuration.

Furthermore, applicant specifically used the term "allows" in the claim language wherein the applicant claimed "at least one panel domain is a conformable panel domain that *allows* the panel to reversibly bend from a planar to a non planer configuration" meaning that the panel domain only has to be capable to reversibly bend from a planar to a non planar configuration and not be bent in a non planer configuration. The compressible and resilient material of the panel is capable of bending, even the rigid portions of the foam is capable of bending from a planar configuration to a non planar configuration however may not be easy to bend or aesthetically pleasing after bending the panel, however is still capable of bending.

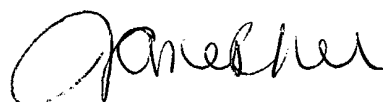
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee
November 30, 2004



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

12/1/04